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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/646,995      | 09/25/2000  | Karl-ulrich Stein    | P00-1787            | 2572             |

7590 06/30/2004

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EXAMINER

HAMILTON, LALITA M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/646,995

Applicant(s)

STEIN, KARL-ULRICH

Examiner

Lalita M Hamilton

Art Unit

3624

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1-13 are objected to because of the following informalities: In claim 1, "using said respective Internet access network one of said mobile..." is incomplete. The Applicant is respectfully requested to correct the wording of the claim make each limitation clear. Appropriate correction is required.

Claim 5 is objected to, because the semicolon at the end should be a period.

Claims 2-13 are objected to because of their dependency on claim 1.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 11-12 been renumbered 12-13.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Morrill (5,991,749).

Morrill discloses a wireless telephony for conducting financial transactions and authorizing other activities utilizing the method of using various Internet access networks with mobile Internet-compatible communication terminal devices, comprising the steps of providing, in said Internet access networks, at least one respective interface for a cash-free payment for a use of one of said respective Internet access networks which is a respective Internet access network, setting up a traffic relationship to said at least one respective interface in a framework of a logon of a mobile communication terminal device in said respective Internet access network, and using said respective Internet access network one of said mobile communication terminal devices which is a communication terminal device after said cash-free payment via said at least one respective interface that is effected by said communication terminal device (col.3, line 65 to col.6, line 12 and col.10, lines 60-65); providing and utilizing in said Internet access network a mobile Internet protocol for realizing a communication terminal device mobility (col.3, line 65 to col.6, line 12 and col.10, lines 60-65); communicating, to said at least one respective interface via said communication terminal device and via said respective Internet access network, credit card information and at least one of an

identifier and a personal identifier that assists said cash-free payment (col.3, line 65 to col.6, line 12 and col.10, lines 60-65); reading said credit card information in said mobile communication terminal devices with assistance of reader devices for credit cards or input devices (col.3, line 65 to col.6, line 12 and col.10, lines 60-65); communicating an electronic signature, in a framework of a security system of said cash-free payment, from an affected communication terminal device to said at least one respective interface (col.3, lines 47-63); representing said mobile communication terminal devices by communication radio network communication terminal devices and representing an Internet access network by at least one Internet server connected to a communication radio network (col.3, line 65 to col.6, line 12 and col.10, lines 60-65); representing said mobile communication terminal devices by portable communication fixed network communication terminal devices; and representing an Internet access network by at least one Internet server connected to a communication fixed network (col.3, line 65 to col.6, line 12 and col.10, lines 60-65); integrating or arranging said at least one respective interface in said at least one Internet server (col.3, line 65 to col.6, line 12 and col.10, lines 60-65); cash-free payment is implemented utilizing said mobile communication terminal devices (col.3, line 65 to col.6, line 12 and col.10, lines 60-65); setting up a connection to one of said Internet access networks via feeder networks of public or private communication fixed networks or communication radio networks, producing a traffic relationship to said at least one respective interface in a framework of a logon of a mobile communication terminal device in said respective Internet access network, communicating an identification and credit card information between a

Art Unit: 3624

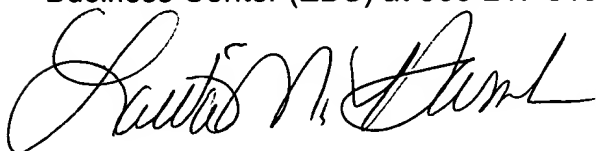
requesting communication terminal device and at least one respective interface in a framework of a payment procedure for cash-free payment, and subsequently granting access to the Internet via said respective Internet access network to said requesting communication terminal device (col.3, line 65 to col.6, line 12 and col.10, lines 60-65); a connection to the Internet access network (IN-AN) is set up via the feeder networks (AN) of public or private communication fixed networks (KFN) or communication radio networks (KMN), the commercial interface (SSB) is introduced during a logon procedure between the respective Internet access network (IN-AN) and the communication terminal device (KE) requesting an Internet access, identification and credit card information (id, ki) are communicated between the commercial interface (SSB) in the framework of a payment procedure for cash-free payment, and access to the Internet (IN) via the Internet access network (IN-AN) is subsequently granted to the requesting communication terminal device (KE) (col.3, line 65 to col.6, line 12 and col.10, lines 60-65); encrypting, in communication terminal device-associated fashion, identifying information selected from the group consisting of said credit card information, said identifier and said personal identifier and communicating said identifying information to said at least one respective interface (col.9, line 60 to col.10, line 10); and integrating or arranging said at least one respective interface in said at least one Internet server (col.3, line 65 to col.6, line 12 and col.10, lines 60-65).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Lalita M. Hamilton', is written over the printed name.

LMH